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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,034	07/24/2006	Yoshifumi Yonemoto	L9289.06172	9251

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EXAMINER
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SORKOWITZ, DANIEL M

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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09/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,034	<b>Applicant(s)</b> YONEMOTO ET AL.	
	<b>Examiner</b> DANIEL M. SORKOWITZ	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/4/07 and 7/24/06</u> .                                      | 6) <input type="checkbox"/> Other: _____                          |

***Notice to Applicant***

This communication is in response to the application 10587034 filed on 7/24/2006. Claims 6-10 have been examined.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 1. Claims 6-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**Regarding claims 6-8**, based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method or

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process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

**Regarding claim 9**, this claim recites a system that appears to comprise merely software modules that are not clearly embodied on a computer readable medium. However, this is just descriptive material (e.g. software), which is non-statutory under 35 USC 101. MPEP 2106.01 states that “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. This descriptive material is non-statutory when claimed as descriptive material *per se*. When functional descriptive material is recorded on a computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2. Claims 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Regarding claims 9 and 10**, these claims repeatedly recite the limitation “a section”. The claims recite a terminal, and structure is required to further limit an apparatus. It is unclear what structure is being claimed by use of the word “section”. This appears to be merely directed towards programming, which makes the claim unclear. Since it is unclear as to what applicant is intending to claim, the claim itself becomes indefinite. For the purposes of applying prior art, the Examiner will interpret the term “section” to be programming.

***- Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language.

**3. Claims 6-10 are rejected under 35 U.S.C. 102 (e) as being anticipated by US Patent Number 6,804,659 to Graham et al.**

**Regarding claims 6 and 9-10,** Graham discloses receiving content and control rule information for performing control of extracting search information in accordance with search characteristics of a user at a content playback terminal (figure 5, 510-514 column 10 lines 45- 67 and column 11 lines 1-11);storing history information for search for the received content (figure 6a, 614-618 column 11 lines 45-51); analyzing the received control rule information and extracting, from the history information, search information in accordance with the search characteristics of the user (figure 6a 510-618, figure 6b 512-618 column 11 lines 45-67, column 12 lines 1- 22); selecting new content corresponding to the search information; and playing back the new content (figure 11a 1512, column 4 lines

43-63, column 15 lines 8-23). Graham further discloses the terminal (figure 2-3).

**Regarding claim 7,** Graham discloses the history information includes purchase history information for products the user has purchased (column 4 lines 46-49); the search information includes information for a product of a maximum number of purchases extracted from the purchase history information (column 4 lines 46-49); and the step of preferentially selecting the new content comprises a step of preferentially selecting new content including the information for the product having a maximum number of purchases (column 4 lines 46-63, Graham discloses selecting content based all product usage which would inherently include the product with the maximum number of purchases).

**Regarding claim 8,** Graham discloses the history information includes the purchase history information for products the user has purchased (column 4 lines 46-49); the search information includes information for a product purchased last, the information being further extracted from the purchase history information based on purchase time information for the product purchased last (column 4 lines 46-49); and the step of preferentially selecting the new content comprises a step of preferentially selecting new content including the information for the product purchased last (column 4 lines 46-63, Graham discloses selecting content based all product usage which would inherently include the last purchase);

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US Patent Application Publication Number 2004/0193488 by Khoo et al. "Method and system for advertising over a data network"
- US Patent Application Publication Number 2003/0028565 by Landsman et al., "Technique for implementing browser-initiated user-transparent network-distributed advertising and for interstitially displaying an advertisement, so distributed, through a web browser in response to a user click-stream "

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL M. SORKOWITZ whose telephone number is (571)270-5206. The examiner can normally be reached on Monday through Friday from 8:30AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 571.272.6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)? If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. M. S./  
Examiner, Art Unit 3622

/M. B./  
Examiner, Art Unit 3622

/Eric W. Stamber/  
Supervisory Patent Examiner, Art Unit 3622